

REMARKS

I. Introduction

Upon entry of the present amendment, claims 1-12 will be pending in this application. Claims 1, 4-6, and 11-12 have been amended to clarify the features of the invention. Support for these amendments can be found in the specification. No new matter has been added.

Based on the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

II. Drawings

Replacement drawings have been submitted. These replacement drawings are submitted to facilitate a clear understanding of the disclosed invention. Each new replacement sheet is labeled as "Replacement Sheet." No new matter has been added.

III. Rejections based on 35 U.S.C. § 112

The Examiner has rejected claims 4-8, 11 and 12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner stated that neither the specification nor the drawings provide support for a wing cutter or bearing follower as set forth in claims 4-8, 11 and 12. A wing cutter is described in the specification and is specifically mentioned at page 5. A bearing follower is described in the specification at page 2. However, for clarity, Applicant has amended the claims to refer only to a "cutter" or a "bearing," both of which are clearly mentioned multiple times throughout

the specification. Applicant therefore respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

The Examiner has also rejected claims 4-8 and 10-12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

First, claims 4-6 have been amended so that there is proper antecedent basis for "the cutter" in amended claims 4-6.

Second, claim 1 has been amended to provide proper antecedent basis for "the cutter width" in claims 7-8.

The Examiner has requested clarification of the term "wing cutter." The term "the wing cutter" refers to the cutters of this invention as described in the specification. The term "wing cutter" is used specifically at page 5 of the specification. However, as discussed above, Applicant has amended the claims to refer to the "cutter."

Finally, with regard to claims 10-12, the Examiner has requested clarification of the terms "the product of the radius R." When read in its entirety, however, applicant believes the Examiner will understand the entire phrase: "the cutting diameter of the router cutter is larger than the product of the radius R *multiplied by* the square root of 2." The Examiner has correctly noted that "a difference exists between the guide bearing radius and the cutting radius of the router, that difference to be greater than the radius of the guide bearing multiplied by the square root of 2." Office Action, page 5.

For these reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

IV. Rejections based on 35 U.S.C. § 103

A. Claims 1-3 and 9: Pozzo

The Examiner has rejected claims 1-3 and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,899,252 to Pozzo. Applicants respectfully traverse these rejections and request reconsideration and withdrawal thereof.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See M.P.E.P. § 2142.

The Examiner has failed to present a *prima facie* case of obviousness because the cited references do not teach or suggest the claim limitations. The Examiner has stated that Pozzo discloses a router cutter for cutting a "panel-receiving groove." However, Pozzo actually discloses a profile cutter, which is a cutter used for cutting a panel *tongue*. The cutter of Pozzo is used to cut the "tongue," or the part that is received in a groove, and not the groove itself. In contrast, the claimed invention is directed to a router cutter that cuts the groove itself. Pozzo fails to disclose a router capable of creating a slot or groove as described and claimed. The geometry of the Pozzo cutter supports only creating a tongue,

and the cutter only cuts on its upper side. The Pozzo cutter is incapable of cutting on its lower side because the cutting teeth (43) do not extend below the bottom of the cutter. It would be impossible or at least impractical to manufacture a router bit with four cutters for "slotting" due to the fairly large finished size.

Finally, the Examiner cited *In re Rose*, 42 C.C.P.A. 817 (CCPA 1955), asserting that "limitations pertaining to size are not sufficient to patentably distinguish over the prior art." Office Action, page 6. *In re Rose* specifically held that a particular limitation was "patentably significant since it at most relates to the size of the article under consideration which is not ordinarily a matter of invention." *In re Rose*, at 822. As demonstrated above, Pozzo does not disclose the claimed invention, in any size or dimension. Moreover, *Gardner v. TEC Systems Inc.*, also cited by the Examiner, held that "the dimensional limitations did not specify a device which performed and operated any differently from the prior art." In contrast and as also demonstrated above, the claimed device and Pozzo perform and operate differently, so that *Gardner* is not applicable.

Thus, Pozzo fails to teach or suggest all of the claim limitations of claim 1-3 and 9. For these reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

B. Claims 10 and 11-12: B.S. Vaughan in view of Hansen

The Examiner has rejected claims 10 and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,933,232 to B.S. Vaughan in view of U.S. Patent No. 4,505,086 to Hansen. Applicants respectfully traverse these rejections and request reconsideration and withdrawal thereof.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See* M.P.E.P. § 2142.

The Examiner has failed to present a *prima facie* case of obviousness because the cited references do not teach or suggest the claim limitations. The Examiner has stated that Vaughan discloses a method for cutting a groove. Vaughn does not disclose a method for cutting a groove; Vaughan discloses a method of creating *rabbets* by using templates. A rabbet is not a groove. The shaft of the Vaughan tool bears against the template, not against the workpiece. In addition, the frame pieces of Vaughan are not temporarily assembled, as in the claimed invention. Rather, the frame pieces of Vaughan are secured at the corners using corrugated nails, which cannot be removed without damaging the workpiece.

In contrast, the claimed invention relates to creating slots, and more particularly an unending slot within the confines of a frame which can fully trap a panel. The tool of Vaughan cannot be used to create an unending, continuous slot.

Thus, the cited references do not teach or suggest all of the limitations of the claimed invention. For these reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

CONCLUSION

In light of the amendments and the above remarks, Applicants are of the opinion that the Office Action has been completely responded to and that the application is now in condition for allowance. Such action is respectfully requested.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6188 is respectfully solicited.

Respectfully submitted,

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